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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,903	07/11/2003	Alexander K. Schowtka	03-008	4900

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VISTA PRINT USA INC.
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EXAMINER

LAY, MICHELLE K

ART UNIT	PAPER NUMBER
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2628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/19/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/617,903

Applicant(s)

SCHOWTKA ET AL.

Examiner

Michelle K. Lay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The preliminary amendment filed 07/13/2006 has been entered and made of record. Claims 1-29 are pending.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 12/13/2004 and 07/13/2006 is being considered by the examiner.

Additionally, references 2002/025085 and 2002/191861 were listed numerically incorrectly. Instead, Examiner cites 2002/0025085 to Gustafson et al. and 2002/0101861 to Cheattle. The references will be cited in PTO 892 – References Cited by Examiner in order to be made of record.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "130" in Fig. 1 and "150" in paragraph [0021] in the disclosure have both been used to designate input devices. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims **20-23, 26, 27 and 29** are rejected under 35 U.S.C. 102(a) as being anticipated by Roses (2003/0055871 A1).

In regards to claim **20**, Roses teaches a document composition application allowing a user to create a document having selected images incorporated therein. The document composition application (206) may create poster size documents, as well as smaller, conventional-sized documents [0028]. Referring to Fig. 2, the document composition website (110) has a template database (204) for storing templates [0028]. A template (said **layout**) includes a predefined format, such as areas (said **image containers**) of a document having fixed (said **associated size and position**) images and/or text and areas for placing selected images and/or custom text [0033]. Referring to Fig. 5, web page (500) facilitates selection of a template. A template selection area includes a "Select" button (524) for selecting the template (said **plurality of layouts**) [0042]. In

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step (415) of Fig. 4, an image to be incorporated in the template is selected and received, e.g. the image basket application (212) is called, and images from other web sites or images stored in the web site (11) that may be used by the user (125) are retrieved [0035]. As shown in Fig. 6, an image placement area (606 facilitates placement of an image selected using an image selection area (608). The image selection area (608) includes navigation buttons (609) an image name (610) of a displayed image (611). The navigation buttons (609) allow the user (125) to navigate through images in an image basket (said **selecting image**). Additionally, a warning area (614) displays warning messages when appropriate, such as, "image does not fit in selected area" and the like (said **determining**) [0043]. Thus, the method/system of Roses, determines the size of the image container within the layout. Once the layout and image/text are selected, the document creation and selection module (310) generates the complied document (said **product design**) [0032]. The templates having similar attributes may be includes in-group (e.g., slideshow group, poser group, and the like). A user (125) may select a template group from multiple groups [0033]. Additionally, Roses teaches setting image attributes of the image selected, such as scaling, cropping, filtering and location within the template for the selected image [0037].

In regards to claims 21 and 22, Roses teaches a "Preview" button (614) to view a preview of the document with the edited (e.g. cropped) images (said **displaying product design**) [0043]. Furthermore, once the layout and image/text are selected, the

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document creation and selection module (310) generates the complied document (said **combining**) [0032, 0045].

In regards to claim **23**, Fig. 6 illustrates exemplary web page (600) for selecting images to be incorporated into a selected template. The navigation buttons (609) allow the user (125) to navigate through the images in an image basket [0043].

In regards to claims **26** and **27**, referring to Fig. 5 of Roses, web page (500) displayed by web site (110) is used for selection of a template (said **input received**) [0042].

Templates having similar attributes may be included in a group (e.g., slideshow, poster, etc.) [0033].

In regards to claim **29**, claim 29 recites the same limitations as claims 20. Therefore, the same rationale used for claims 20 is applied. Furthermore, Roses teaches a software structure of the system/method of Roses [0046].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-6, 9-19, 24, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roses (2003/0055871 A1) in view of Garrett et al. (5,557,728).

Roses teaches the limitations of claims **1-6, 9-19, 24, and 25** with the exception of explicitly teaching a selection criteria. However, Garrett teaches retrieving images from an image database search and outputting the images to a display screen with a specified output area.

In regards to claim **1**, Roses teaches a document composition application allowing a user to create a document having selected images incorporated therein. The document composition application (206) may create poster size documents, as well as smaller, conventional-sized documents [0028]. Referring to Fig. 2, the document composition website (110) has a template database (204) for storing templates [0028]. A template (said **layout**) includes a predefined format, such as areas (said **image containers**) of a document having fixed (said **associated size and position**) images and/or text and areas for placing selected images and/or custom text [0033]. Referring to Fig. 5, web page (500) facilitates selection of a template. A template selection area includes a "Select" button (524) for selecting the template (said **plurality of layouts**) [0042]. In step (415) of Fig. 4, an image to be incorporated in the template is selected and received, e.g. the image basket application (212) is called, and images from other web sites or images stored in the web site (11) that may be used by the user (125) are retrieved [0035]. As shown in Fig. 6, an image placement area (606 facilitates placement of an image selected using an image selection area (608). The image

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selection area (608) includes navigation buttons (609) an image name (610) of a displayed image (611). The navigation buttons (609) allow the user (125) to navigate through images in an image basket [0043]. Once the layout and image/text are selected, the document creation and selection module (310) generates the complied document (said **product design**) [0032]. The templates having similar attributes may be includes in groups (e.g., slideshow group, poser group, and the like). A user (125) may select a template group from multiple groups [0033]. Thus, the compiled document is based on a selection criterion placed on the selected images and the selected template.

Garrett teaches using a standard keyword search on an image database incorporating a computer terminal to enable user interaction, in order to retrieve images (said **selection criterion**) [col. 4, lines 18-22; col. 5, lines 8-11].

Therefore, it would have been obvious to one of ordinary skill in the art to implement the keyword search of Garrett when selecting an image from the image basket of Roses, rather than using the navigation buttons of Roses, so that a more efficient and time saving method can be implemented in order to effectively find the desired image to place in the document of Roses.

In regards to claims 2, 3, 5, and 6, Roses teaches the template to include fixed images and areas for placing selected images [0033]. Furthermore, the user can select a pre-designed layout containing predetermined sizes of image containers [0042-0043].

Furthermore, in regards to claim 6, the limitation "*at least some of*" fails to further limit

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the claim to a specified number of pre-determined sizes, thus the pre-determined image size within the templates of Roses meets this limitation.

In regards to claim **4**, Garrett teaches using a standard keyword search on an image database incorporating a computer terminal to enable user interaction, in order to retrieve images [col. 4, lines 18-22; col. 5, lines 8-11]. Thus, it would have been obvious for a group of images to be found, with variations of the same base image, such as using the keyword "Christmas". Thus the user can select from a group of Christmas images to be placed in the document.

In regards to claims **9** and **10**, Roses teaches the template's general information comprising color scheme. Furthermore, such information can be edited [0039]. Thus, the user can opt to alter the color schemes based on the selected images from web page (600) shown in Fig. 6.

In regards to claim **11**, Roses teaches a document composition application (206) for creating, editing, viewing, printing and distributing documents. The document server (202) is connected to a template database (204) for storing templates, such as templates for creating documents, and a document database (205) for storing documents. The document composition application (206) may create poster size documents, as well as smaller, conventional-sized documents [0028]. Thus, the user selects the type of layout needed based on the product the user wants to create.

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In regards to claim **12**, Roses teaches the template may include areas having fixed images and areas for placing selected images [0033]. As shown in Fig. 5, a description of the template (518-522) is provided to the user to aid in the selection. Thus, the user can view the layout (518, 520) of the images and can opt for that template based on the number of images desired. Referring to Fig. 6, an image placement area (606) (said **image container**) facilitates placement of an image selected using an image selection area (608) [0043].

Furthermore, Garrett teaches the user retrieving desired images form a database. Based on the number of images retrieved, the divider (40) of Garrett determines how the corresponding images will be positioned (said **layout**) in the display area of the monitor (80) [col. 5, lines 35-39].

Thus, it would have been obvious to one of ordinary skill in the art to implement the layout based on the number of images, as taught by Garrett in order to avoid having to cycle through possible templates of Roses in order to find a template that matches the number of images the user desires. This would provide a more efficient and time saving method in order to effectively select the proper template to support the number of desired images.

In regards to claim **13**, Garrett teaches using a standard keyword search on an image database incorporating a computer terminal to enable user interaction, in order to retrieve images (said **selection criterion**) [col. 4, lines 18-22; col. 5, lines 8-11]. The same rationale for combining as applied to claim 1 is incorporated herein.

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In regards to claim **14**, referring to Fig. 4 of Roses, Roses teaches image attributes of the image selected are set by the user (125), such as scaling, cropping, filtering and location within the template for the selected image are set by the user (125). This may be repeated for each image incorporated in the template [0037]. Additionally, text to be included in the template is entered by the user. Attributes (e.g., font, color, size, location and the like) are selected by the user and repeated for each area of the template that includes entered text [0038] (said ***user supplied content***). Furthermore, the document server (202) may utilize available printing services or transmit the final document in electronic form to the user and be readily printed by the user [0028]. The document composition application (206) is functional to create, preview, print, facilitate purchase of documents, and the like. A preview and purchase module (320) generates files that may be printed and purchased (said ***producing product in physical form***) [0032].

In regards to claim **15**, claim 15 recites the same limitations as claim 1. Therefore, the same rationale used for claim 1 is applied. Furthermore, referring to Fig. 2, Roses teaches a document server (202), a template database (204) (said ***layouts stored on the server***), image basket server (208) (said ***images stored on the server***). The communication server (230) facilitates communication with other web sites and each user (125) (said ***means responsive***) [0027-0032]. The user interacts with such servers via a document composition web site (110) using a conventional device (e.g., computer, personal digital assistant, web phone, and the like).

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In regards to claim **16**, Roses teaches a document composition application (206) used to create, preview, print, facilitate purchase of documents, and the like [0032]. Thus, through the creation process, the composition application combines selected layouts and images from the template database (204) and image basket server (208) to produce the final result.

In regards to claim **17**, claim 17 recites the same limitations as claims 1 and 15.

Therefore, the same rationale used for claims 1 and 15 is applied. Furthermore, Roses teaches a software structure of the system/method of Roses [0046].

In regards to claim **18**, claim 18 recites the same limitations as claims 16 and 17.

Therefore, the same rationale used for claims 16 and 17 is applied.

In regards to claim **19**, claim 19 recites the same limitations as claims 2, 3, and 17.

Therefore, the same rationale used for claims 2, 3, and 17 is applied.

In regards to claims **24** and **25**, claims 24 and 25 recites the same limitations as claims 13 and 20. Therefore the same rationale used for claims 13, and 20 is applied.

Furthermore, it would have been obvious to one of ordinary skill in the art to implement the keyword search of Garrett when selecting an image from the image basket of Roses, rather than using the navigation buttons of Roses, so that a more efficient and

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time saving method can be implemented in order to effectively find the desired image to place in the document of Roses.

3. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roses (2003/0055871 A1) in view of Garrett et al. (5,557,728) as applied to claim 6, and in further view of Wang et al. (6,028,603).

Roses in view of Garrett teach the limitations of claims 7 and 8 with the exception of disclosing the retained image including height and width. However, Wang teaches a system/method for presenting a collection of digital media in a media container. In regards to Fig. 15 of Wang, whenever an image is placed into a picture slot (said **image container**) the image is scaled using conventional scaling techniques to fit into the slot (said **version of retained image**) while at the same time maintaining the aspect ratio of the original image [col. 15, lines 31-36]. Although Wang does not explicitly teach at least two points, it would have been obvious to one of ordinary skill to consider the at least two points to be the corners of the image container. Thus, it would have been obvious to one of ordinary skill in the art to include the aspect ratio of the image container and the selected image, in order to determine the proper scaling.

Furthermore, Roses teaches setting image attributes of the image selected, such as scaling, cropping, filtering and location within the template for the selected image [0037].

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4. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roses (2003/0055871 A1) in view of Wang et al. (6,028,603).

Roses teaches the limitations of claim 28 with the exception of explicitly disclosing resizing the selected image prior to cropping. However, Wang teaches a system/method for presenting a collection of digital media in a media container. In regards to Fig. 15 of Wang, whenever an image is placed into a picture slot (said **image container**) the image is scaled using conventional scaling techniques to fit into the slot while at the same time maintaining the aspect ratio of the original image [col. 15, lines 31-36]. Furthermore, Wang teaches that as a result, pixels in one direction will not be completely filled up. Thus, it would have been obvious to one of ordinary skill in the art to then crop the scaled image once it has been resized and scaled for the image container so that the entire image container is filled, without any empty space. Roses teaches setting image attributes of the image selected, such as scaling, cropping, filtering and location within the template for the selected image [0037].

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hu et al. (6,825,860 B1)

Cheatle (2002/0191863 A1)

Herbert et al. (2004/0257380 A1)

Gustafson et al. (2002/0025085 A1)

Nojima et al. (5,930,811)

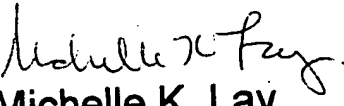
Cannon et al. (5,748,484)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle K. Lay whose telephone number is (571) 272-7661. The examiner can normally be reached on Monday-Friday 7:30a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee M. Tung can be reached on (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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